

REMARKS

The present application is directed to endostatin proteins comprising a fragment of a NC1 region of a collagen protein. The proteins have the ability to inhibit angiogenesis.

Claims 52-55, 57-66, and 68-73 are pending in the above-identified patent application. Claims 52 and 63 have been amended and Claims 62 and 73 have been cancelled. No new matter is introduced by the amendments and support for the amendments is found throughout the specification. Applicants respectfully assert that the amendments to the claims do not diminish the scope of the invention as originally claimed. Based on the foregoing amendments and the following remarks, Applicants respectfully request allowance of all of the pending claims.

Rejection of Claims 52-55, 57-66, and 68-73 As Being Unpatentable Over U.S. Patent No. 5,854,205

In the office action dated May 29, 2003, the Examiner maintained the rejection of Claims 52-55, 57-66, and 68-73 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-7 and 17-23 of U.S. Patent No. 5,854,205 for reasons of record set forth in the December 19, 2000 office action.

In an effort to facilitate prosecution, Applicants submit a terminal disclaimer herewith in compliance with 37 C.F.R. §3.37(b). Reconsideration and withdrawal of this rejection is therefore respectfully requested.

Rejection of Claims 52-55, 57-66, and 68-73 As Being Unpatentable Over U.S. Patent No. 6,346,510

In the office action dated May 29, 2003, the Examiner maintained the rejection of Claims 52-55, 57-66, and 68-73 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-11 of U.S. Patent No. 6,346,510.

In an effort to facilitate prosecution, Applicants submit a terminal disclaimer herewith in compliance with 37 C.F.R. §3.37(b). Reconsideration and withdrawal of this rejection is therefore respectfully requested.

Serial No. 09/405,499
Response dated December 1, 2003
Response to Office Action of May 29, 2003

Rejections under 35 U.S.C. §112, first paragraph

Claims 52-55, 57-66 and 68-73 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Specifically, the Examiner stated that the specification, while being enabling for endostatin (as defined by its molecular weight, N-terminal sequence and ability to inhibit endothelial cell proliferation in vitro), does not reasonably provide enablement for a protein comprising or consisting of any fragment of NC1. The reasons for the rejection remained the same as in paper no. 9 mailed July 19, 2001. In an effort to facilitate prosecution, applicants have amended the relevant claims by defining the characteristics of endostatin. Reconsideration and withdrawal of this rejection is therefore respectfully requested.

Rejections under 35 U.S.C. §112, first paragraph

Claims 52-55, 57-66 and 68-73 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Specifically, the Examiner stated that "...Seq ID No. 1 and 2 are from collagen XVIII and there is no common structural feature that correlates to function or to applicant having possession of the genus now claimed." In light of the claim amendments discussed above, applicants respectfully submit that the claims have now been amended such that sufficient common structural features have been provided and such that one skilled in the art would understand the nature of the invention without requiring undue experimentation. Reconsideration and withdrawal of this rejection is therefore respectfully requested.

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Conclusion

For at least the reasons given above, Applicants respectfully submit that Claims 52-55, 57-61, 63-66, and 68-72 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims. The Examiner is invited and encouraged to contact the undersigned attorney of record at telephone number listed below, if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,



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